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EXAMINER	
ART UNIT	PAPER NUMBER
3301	<i>[Signature]</i>

DATE MAILED: 08/05/96

Please find below a communication from the EXAMINER in charge of this application.

Commissioner of Patents

Office Action Summary

Application No.

08/451,652

Applicant(s)

Deloris G. Wood

Examiner

Benjamin Koo

Group Art Unit

3301



☒ Responsive to communication(s) filed on May 26, 1995

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 23-46 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 23-46 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 21

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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Part III DETAILED ACTION

Claim Rejections - 35 USC § 112

1. Claims 23, 25, 27, 29, 31, 33, 35, 37, 40, 41, and 43 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claims 23, 29, 31, 37, and 40, the phrase "sized and shaped to outline the mouth,..." or "sized and shaped to receive the tongue..." does not properly define the metes and bounds of the invention, since the size and shape of these parts of the body can vary significantly in different individuals. Likewise in claims 27, 35, and 43, the term "the frame is positioned to outline the mouth,..." gives a positional limitation which is indefinite for similar reasons as stated previously. With respect to claims 25, 33, and 41, these claims contain limitations which would be given greater weight in a method claim, but not in an apparatus claim.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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3. Claims 23, 24, 28, 31, 32, 36, and 39 are rejected under 35 U.S.C. § 102(b) as being anticipated by Laguerre '321. Laguerre shows a frame (2a/3a/4a), a removable membrane or sleeve (5a) made out of vinyl (page 1, line 68), and a handle (1a).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

5. Claims 25-27, 30, 33-35, and 38 rejected under 35 U.S.C. § 103 as being unpatentable over Laguerre. Laguerre shows all the functional and structural limitations of the invention as claimed by the applicant including a frame extending "angularly" from the handle since no specific angle is claimed, but does not show the specific frame shape and does not disclose the membrane being impervious to HIV. Although Laguerre does not show the specific frame shape of the applicant's invention

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it is believed that the functional aspect has been met and a simple change in shape without any adverse or unexpected results is to be considered an obvious choice of design to one of ordinary skill for the benefit of allowing the device to fit more comfortable on the user, especially in view of the lack of any spatial or size limitations as pointed out in paragraph 1 of this office action. Furthermore, it has been held that a change in shape within the bounds of one of ordinary skill is not a patentably distinct feature, *In re Dailey*, 149 USPQ 47 (CCPA 1976). Although Laguerre never mentions any specific characteristics of the membrane, Laguerre has shown the identical material as claimed by the applicant, therefore any corresponding physical properties of the material are considered to be inherent within the prior art.

6. Claims 29, 37, 40-45, and 46 are rejected under 35 U.S.C. § 103 as being unpatentable over Laguerre in view of Rubin et al. '456. Laguerre shows all the structural and functional limitations of the invention as claimed by the applicant except for the protuberance. Rubin et al. shows the protuberance. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Laguerre to have included a protuberance, since the use of such a protuberance in the face protecting art is well known to aid the prevention of disease transmittal in circumstances such as french kissing.

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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Ben Koo whose telephone number is (703) 308-2657.

bk
July 30, 1996

**ROBERT A. HAFER
S.P.E.
ART UNIT 331**